

Application Serial No. 10/081,994
Amendment Dated: February 4, 2004
Reply to Office Action Mailed: September 4, 2003

REMARKS

The non-final Office Action mailed September 4, 2003, has been received and reviewed. As of the September 4, 2003 Office Action, Claims 1-31 are pending in the application. Claims 1, 9-11, 18-19 and 30-31 presently stand rejected. Claims 3-8, 12-17 and 20-25 presently stands objected to. Moreover, applicants note with appreciation that Claims 26-29 would be allowable if rewritten to overcome the rejections under § 112, ¶ 2 and to include all of the limitations of the base claim and any intervening claims. Applicants have amended Claims 1,2, 8,9, 12, 13, 16-21, 24-29 and 31. As of this amendment, Claims 1-31 are believed to be in condition for allowance and the applicants respectfully request reconsideration of the application as amended herein.

35 U.S.C. § 112, ¶ 2 Indefiniteness Rejections

The Examiner has rejected Claims 19, 26 and 27 under 35 U.S.C. § 112, ¶ 2 as being indefinite. Applicants have amended Claims 19, 26 and 27 to address the concerns raised by the Examiner. Applicants believe Claims 19, 26 and 27 are now definite and respectfully requests reconsideration of the Examiner's rejection of the claims based on 35 U.S.C. § 112, ¶ 2 for indefiniteness.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 4,516,485 to Miller

Claims 1, 18-19 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Miller. The standard for anticipation as set forth by the Court of Appeals for the Federal Circuit is as follows:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as

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complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 and 18 have been amended to indicate that the "sealed package" is "non-edible." Miller neither teaches nor suggests a "non-edible sealed package." Miller specifically teaches a "hot dog 12" throughout the disclosure. A "hot dog" does not include a "non-edible sealed package" as recited in claim 1 nor a "non-edible substantially sealed package" as recited in claim 18. Thus, the applicants respectfully submit that claims 1 and 18 are not anticipated by Miller and should therefore be in condition for allowance.

35 U.S.C. § 103(a) Obviousness Rejections

The Examiner has rejected claims 2, 9-11 and 30-31 under 35 U.S.C. § 103(a) for obviousness. In order to assert a rejection of the claims under 35 U.S.C. § 103(a), the Examiner must establish a *prima facie* case of obviousness. *In re Fine* 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The test for establishing such a case is well stated in *In re Lintner*, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972) as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teaching would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination or other modification.

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Furthermore, the C.C.P.A. held in *In re Kuderna*, 165 U.S.P.Q. 575 (C.C.P.A. 1970):

We must approach the issue of patentability in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of the first one and then another of the isolated teachings in the art. . . . Where is the reason for one skilled in the art to so emphasize that one isolated teaching?

An excellent summary of how the prior art must be considered to make a case of *prima facie* obviousness is contained in *In re Ehrreich*, 200 U.S.P.Q. 504, 509-11 (C.C.P.A. 1979). There, the court stated that a reference must not be considered in a vacuum but against the background of the other references of record. It is stated that the question of a § 103 case is

what the reference(s) would "collectively suggest" to one of ordinary skill in the art. However, the court specifically cautioned that the Examiner must consider the entirety of the disclosure made by the reference and avoid combining them indiscriminately.

In finding that the "subject matter as a whole" would not have been obvious in *Ehrreich* the court concluded:

Thus, we are directed to no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or a suggestion leading to their combination in the manner claimed by appellants.

Applicants do not dispute that, if one searches the art hard enough, each feature of a claimed invention may be found in some isolated teaching. However, that is not the point of

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“invention.” It has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning led the Federal Circuit, in *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983) to state:

The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.

To establish a *prima facie* case of obviousness with respect to a claimed composition, the prior art must provide some reason or motivation to make the claimed composition, *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (*en banc*). As more recently and aptly stated in *In re Jones*, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (emphasis in original):

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the . . . art would have been motivated to make the modifications of the prior art necessary to arrive at the claimed [invention].

With respect to properly considering the prior art, the C.C.P.A. stated in *In re Carroll*, 202 U.S.P.Q. 571, 572 (C.C.P.A. 1979), as follows:

One of the more difficult aspects of resolving questions of non-obviousness is the necessity “to guard against slipping into use of hindsight.” *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 USPQ 459, 474 (1965). Many inventions may seem obvious to everyone after they have been made. However, 35 USC 103 instructs us to inquire into whether the claimed invention “would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

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When making a rejection under 35 U.S.C. § 103 there are three fundamental areas the Examiner is required, under 37 C.F.R. § 1.106 and MPEP § 706.02, to cover to fulfill the test enunciated in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 454 (1966). First, the rejection should set forth the differences between the claims and the prior art. Second, the proposed modification of the applied references necessary to arrive at the claimed subject matter should be set out. Third, there must be an explanation why such proposed modifications would be obvious.

Obviousness Rejection Based on U.S. Patent No. 4,516,485 to Miller

Claims 2, 9-11 and 30-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller. As Applicant's have amended Claims 1, 9 and 18 to overcome the anticipation rejection based on Miller and claims 10, 11, 30 and 31 depend from those claims, Applicants believe that claims 2, 9-11 and 30-31 are now allowable over the prior art of record.

Allowable Subject Matter and New Claims

The Examiner has indicated that claims 3-8, 12-17 and 20-25 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In addition, the Examiner has indicated that claims 26-29 would also be allowable if rewritten to overcome the rejections under § 112, ¶ 2 and to include all of the limitations of the base claim and any intervening claims. As previously indicated, claims 26-29 have been amended to overcome the rejections under § 112, ¶ 2. The applicants

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respectfully submit that the claims as amended, however, are also allowable over the prior art of record.

ENTRY OF AMENDMENTS

The amendments to Claims 1, 2, 8, 9, 12, 13, 16-21, 24-29 and 31 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Moreover, it should be noted that the amendments to claims rejected under § 112, ¶ 2 were included merely to correct minor deficiencies in the claims and should not be construed as a limitation to the claims or equivalents of elements contained therein. Moreover, amendments to the dependent claims that were not objected to or rejected by the Examiner, were included merely to make sure that the claims properly reflected any amendments made to the independent claims. Thus, once again, such amendments should not be construed to limit the scope of equivalents properly afforded such claims.

CONCLUSION

Claims 1-31 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact the applicants' undersigned attorney.

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The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0881.

Respectfully Submitted,



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